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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/496,222	02/01/2000	Jeffry Jovan Philyaw	PHLY-24.583	5890
25883	7590	12/05/2003	EXAMINER	
HOWISON & ARNOTT, L.L.P			KANG, PAUL H	
P.O. BOX 741715			ART UNIT	
DALLAS, TX 75374-1715			PAPER NUMBER	
			2141	26
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/496,222

Applicant(s)

PHILYAW ET AL.

Examiner

Paul H Kang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. Claims 22-31 are pending. Claims 22-31 are rejected.
2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 22-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,377,986 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is the same as the context of the patent.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the

manner in which the invention was made.

4. Claims 22-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al., US Pat. No. 5,978,773, in view of Epstein, US Pat. No. 6,601,172 B1.

5. As to claim 22, Hudetz teaches a method for obtaining information regarding the source of a product from a remote information source location on a global communication network utilizing a product code associated with the product and unique thereto, comprising the steps of:

scanning the product code associated with the product with a scanner at a user location on the global communication network to extract therefrom the information contained in the unique product code (Hudetz, abstract and col. 3, line 17 – col. 4, line 30);

assembling a packet of information at the user location comprised of the extracted product code and the unique code to provide a routing packet (Hudetz, col. 7, line 29 – col. 8, line 46); and

connecting the user location to the remote information source location utilizing the information in the routing packet and in response to the step of scanning, wherein the routing packet is representative of the location of the remote information source location on the global communication network through an association with a routing table (Hudetz, col. 7, line 29 – col. 8, line 46).

However, Hudetz does not explicitly teach pre-associating a unique scan ID code with the scanning operation, which pre-associated unique scan ID is uniquely associated with the location of the scanner on the global communications network and wherein the step of connecting includes a verification step that requires the unique scan ID and product code information to

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have a predetermined relationship in order to be completed. In the same field of endeavor, Epstein teaches the use scanner ID, as well as other indicia, combined with the scanned image to generate a unique relationship. The relationship is stored on the server for future use to access related data (See Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have incorporated using a unique scan ID as taught by Epstein into the system of Hudetz for the purpose of increasing the efficiency of user authentication, data processing and data retrieval.

6. As to claim 23, Hudetz-Epstein teaches that the unique scan ID is an ID permanently associated with the scanner utilized in the step of scanning (Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

7. As to claim 24, Hudetz-Epstein teaches a UPC product code (See Hudetz, abstract).

8. As to claim 25, Hudetz-Epstein teaches the method of claim 22, wherein the step of connecting comprises:

transmitting the routing packet from the user location to a predetermined intermediate location on the global communication network, wherein the intermediate location has a database associated therewith that provides in a stored routing table having associations stored therein to provide a correlation between product codes, unique scan ID codes and routing information

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associated with remote information source locations on the global communication network as the predetermined relationship (Hudetz, col. 7, line 1 – col. 9, line 21);

determining if there exists a match between the unique scan ID code associated with the scanning information and the extracted product code information in the database (Hudetz, col. 7, line 1 – col. 9, line 21);

if there is a match, returning the associated network routing information regarding the associated remote information source location on the global communication network back to the user location (Hudetz, col. 8, line 47 – col. 9, line 21); and

interfacing a user at the user location to the remote information source location in accordance with the returned network routing information (Hudetz, col. 9, lines 5-21).

9. As to claim 26, Hudetz-Epstein teach the method of claim 25, and further comprising the step of returning information from the remote information source location after connection thereto and displaying the returned information on a user computer at the user location (Hudetz, col. 9, lines 5-21).

10. As to claim 27, Hudetz-Epstein teach the method of claim 26, wherein information is returned back to the user computer at the user location to determine the method by which the display is facilitated in accordance with information associated in the database with the unique ID (Hudetz, col. 9, lines 5-21 and Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

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11. As to claims 28, Hudetz-Epstein teach the method of claim 23, wherein the step of scanning comprises:

providing a unique scanner having associated therewith the unique scan ID code (Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47); and

scanning the product code with the provided scanner to extract information therefrom, the step of scanning operable to incorporate the step of associating the unique scan ID code with the scanning operation such that the step of scanning also results in the output of the routing packet (Hudetz, col. 9, lines 5-21 and Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

12. As to claims 29, Hudetz-Epstein teach the method of claim 28, wherein the step of scanning with the provided scanner comprises the step of decoding information in the product code, which product is encoded in a first format to output a value that can be assembled with the unique scan ID code in the routing packet (Hudetz, col. 9, lines 5-21 and Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

13. As to claims 30 and 31, Hudetz-Epstein teach the step of associating is performed in response to the step of scanning and without user intervention (Hudetz, col. 9, lines 5-21 and Epstein, col. 1, lines 11-67 and col. 4, line 18 – col. 3, line 47).

14. Applicant's arguments with respect to claims 22-31 have been considered but are moot in view of the new ground(s) of rejection. The Applicant argued in substance that the prior art

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failed to teach a predetermined relationship between the unique scan ID and product code. The new grounds of rejection teaches this feature.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul H Kang whose telephone number is (703) 308-6123. The examiner can normally be reached on 9 hour flex. First Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (703) 305-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


Paul H Kang
Examiner
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